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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,989	04/05/2001	Jed W. Fahey	046585/0138	4463

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EXAMINER

DELACROIX MUIRHEI, CYBILLE

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 05/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/825,989	FAHEY ET AL.
	Examiner Cybille Delacroix-Muirheid	Art Unit 1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 April 2001.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 48-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 48-52 and 54-57 is/are allowed.
- 6) Claim(s) 58-63 is/are rejected.
- 7) Claim(s) 53 and 64-67 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                           | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 . | 6) <input type="checkbox"/> Other: _____ .                                   |

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## **DETAILED ACTION**

The following is responsive to the preliminary amendment received April 5, 2001.

Claims 1-47 are cancelled without prejudice or disclaimer. New claims 48-67 are added.

Claims 48-67 are presented for prosecution on the merits.

### ***Information Disclosure Statement***

Applicant's Information Disclosure Statement received April 5, 2001 has been considered in part, i.e. US patents. The remaining articles A3-A76 were not in parent application 09/425,890. The Examiner respectfully requests that Applicant submit these references so that they may be considered and made of record.

### ***Claim Objections***

1. Claim 53 is objected to because of the following informalities: in claim 53, lines 1-3, selected from the group consisting of...or is improper Markush terminology. The "or" at line 3, before "plant parts" should be deleted and replaced with --and--. Please see MPEP 2173.05(h). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

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2. Claims 59, 61, 62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 59, 61, 62 recite the limitation "said solvent" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is respectfully requested that Applicant amend claims 59, 61, 62 to add the term --non-toxic-- before "solvent."

***Allowable Subject Matter***

Claims 48-57 are free from the prior art because the prior art does not disclose or fairly suggest Applicant's claimed method.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 58, 59, 62, 63 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones et al., 4,158,656.

Jones et al. disclose a method for extracting glucosinolates, the method comprising contacting seed material (rapeseed) with an aqueous-lower alkanol (water-alcohol, i.e. ethanol)solvent

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solution at a temperature below 60° C and under conditions so as to prevent enzymatic degradation of the glucosinolates. Jones et al. additionally disclose that the temperature is kept below 60° C in order to prevent activation of the myrosinase. Please see claim 1; col. 1, lines 3-6; col. 4, lines 44-63.

6. Claims 58, 59, 63 are rejected under 35 U.S.C. 102(b) as being anticipated by Anjou et al., 4,083,836.

Anjou et al. teach a method for extracting or leaching glucosinolates from seed material, the method comprising obtaining a meat fraction of the seed material and subjecting the meat fraction to a wet state at 80-100°C and leaching the glucosinolates by water, wherein the temperature of the leaching is 60-80°C. Please see the abstract; col. 5, lines 21-57.

**Please note** that Applicant's claims recite "comprising" language. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80USPQ 448, 450 (Bd. App. 1948) ("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts").

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7. Claims 61 and 64-67 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anjou et al., supra.

Anjou et al. as applied above.

Anjou et al. does not disclose that the temperature of the leach water is 100°C; however, since Anjou et al. establish that the glucosinolate leaching process is temperature dependent, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the leaching method of Anjou et al. such that the temperature is effective to result in optimum extraction of glucosinolates from the seed material. Such a modification would have been motivated by the reasoned expectation of successfully extracting glucosinolates from the seed material.

### *Conclusion*

Claims 58, 59, 60, 61, 62, 63 are rejected.

Claims 53, 64-67 are objected to.

Claims 48-57 are free from the prior art.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cybille Delacroix-Muirheid whose telephone number is (703) 306-3227. The examiner can normally be reached on Tue-Fri from 8:30 to 6:00. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on (703) 308-4725. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

CDM *CM*

May 16, 2002

*Cybille Delacroix*  
Cydille Delacroix-Muirheid  
Patent Examiner Group 1600